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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,067	12/11/2001	Patrick W. Gauldin	2690/1	7264

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EXAMINER

OCAMPO, MARIANNE S

ART UNIT PAPER NUMBER

1723

DATE MAILED: 04/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/015,067

Applicant(s)

GAULDIN ET AL.

Examiner

Marianne S. Ocampo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 April 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 12, 13 and 16-18 is/are rejected.
- 7) ☒ Claim(s) 10, 11, 14 and 15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1 – 4 and 16 - 17 are rejected under 35 U.S.C. 102(e) and (a) as being anticipated by Morris et al. (US 6,531,059B1).

3. With respect to claim 1, Morris et al. disclose a silt filtration system adapted for placement at an inlet of a storm water catch basin (140) and cooperating with a grate (150) located adjacent a street curb (146) at a mouth (144) of the inlet to separate silt and debris entrained in storm water entering the catch basin (140), said system comprising a frame (830, 340, 350, walls surrounding basket 365) adapted for residing between the grate (150) and the mouth (144) of the inlet and having an elongated front, rear and opposing side frame members, a filtration member (365) supported within said frame (210, 830) and arranged to filter storm water entering the catch basin (140) through the grate (150) and a backslash (210, 110) attached to the rear frame member and adapted for extending outwardly from the grate (150) and upwardly into an open curb space between the grate (150) and the curb such that storm water splashing over the grate and into the curb space is deflected by the backslash into the filtration medium within said frame, as in figs. 1 - 3 and cols. 4 - 13.

4. Concerning claim 2, Morris et al. also disclose the filtration medium (310, 365) comprising a silt bag (i.e. bag-shaped basket filter formed of reinforced cloth or mesh, 365), as in fig. 3 and in col. 8.

5. With regards to claim 3, Morris et al. further disclose the system further comprising cooperating front and rear support rods (130, 830) extending between the opposing side frame members for suspending the silt bag (365) from said frame, as in figs. 1 - 3.

6. Regarding claim 4, Morris et al. disclose the silt bag (365) comprising open-ended front and rear sleeves formed along a top marginal portion thereof for receiving respective front and rear support rods (130), as in figs. 1 – 3.

7. With respect to claim 16, Morris et al. disclose a method of filtering silt and debris entrained in storm water entering a below-grade catch basin (140) through a grate (150) located at an inlet of the catch basin adjacent a street curb, the method comprising the steps of positioning a filtration medium (365) within a frame (box-like frame 120 surrounding the filtration medium 365) residing between the grate and a mouth of the inlet of the catch basin (140) and the frame having elongated front, rear and opposing side frame members (walls) and attaching a backslash (110, 211) to at least the rear frame member and the backslash extending outwardly from the grate (150) and upwardly into an open curb space (defined by the ledge 142) such that storm water splashing over the grate and into the curb space is deflected by the backslash into the filtration medium (365) within the frame (120, 220), as in figs. 1 – 3 and in cols. 1 – 16.

8. Regarding claim 17, Morris et al. further discloses the method comprising removing the frame (120, 220) and filtration medium (365) from the mouth of the catch basin (140) to empty silt and debris captured by the filtration medium (365), as in cols. 10 – 17.

*Claim Rejections - 35 USC § 103*

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morris et al. in view of DiLoreto Jr. et al. (US 6,149,803).

11. With respect to claim 18, Morris et al. disclose the method further comprising the step of removing the frame (210, 452) and filtration medium (365) attached thereto comprising securing lift hooks (412, 422 of device 440) to the frame, as in figs. 4 & 9 and cols. 13 - 14. Morris et al. fail to disclose the securing step includes securing the lift hooks to (respective) lift eyes attached to the frame. DiLoreto Jr. et al. teach a method of filtering silt and debris in storm water entering a catch basin (10) through a grate (12) located at an inlet of the catch basin (10) adjacent a street curb and the method comprising positioning a filtration medium (36) within a frame (46, 44, 42) residing between the grate and mouth of the inlet and the frame including elongated front, rear and opposing side frame members (42, 44) and removing the frame and filtration medium (30, 36, 44, 46) from the mouth of the catch basin (10) to empty the silt and

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debris captured by the filtration medium (36), and further comprising securing the lift hooks (70) to (respective) lift eyes (68) attached to the frame (46), as in figs. 2, 6 – 7 and cols. 3 – 5. It is considered obvious to one of ordinary skill in the art at the time of the invention to modify the method of Morris et al. by adding the step/embodiment taught by DiLoreto Jr. et al., in order to provide an alternative step for removing the filtration medium together with the frame from the catch basin, as a matter of choice of the user.

12. Claims 1 – 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lewis (US 6,294,095 B1) in view of McInnis (US 6,200,484 B1).

13. Regarding claim 1, Lewis discloses a silt filtration system (20) adapted for placement at an inlet of a storm water catch basin (10) and cooperating with a grate (16) located adjacent a street curb at a mouth of the inlet to separate silt and debris entrained in storm water entering the catch basin (10), said system (20) comprising a frame (22) adapted for residing between the grate (16) and the mouth of the inlet and having an elongated front, rear and opposing side frame members (26 & 24), a filtration member (38) supported within said frame (22) and arranged to filter storm water entering the catch basin (10) through the grate (16) and a backsplash (deflector, 60) attached to (i.e. being removably connected during assembly) to the rear frame member (28, 26) by means of bars 66 and adapted for extending outwardly from the grate (16) and upwardly into an open curb space between the grate (16) and the curb such that storm water splashing over the grate and into the curb space is deflected by the backsplash into the filtration medium within

said frame, as in figs. 1 – 8 and cols. 4 – 6. Lewis fails to disclose the backsplash being attached to (i.e. fixedly/permanently connected) to the rear frame member. McInnis teaches a similar silt filtration system to that of Lewis including a frame (in the form of a circular plate (portion of the deflector plate having the opening to receive the filter element 26) residing between a grate (30) and a mouth of an inlet of a storm water catch basin (14), a filtration medium (26) supported within the frame and arranged to filter storm water entering the catch basin (14) through the grate (30) and a backsplash (22) attached (i.e. integrally attached or permanently connected) to the frame and adapted to extend outwardly from the grate (30) and upwardly into an open curb space between the grate and the curb such that storm water splashing over the grate and into the curb space is deflected back by said backsplash (22) into the filtration medium within the frame, as in fig. 2 and cols. 4 - 6. It is considered obvious to one of ordinary skill in the art at the time of the invention to modify the silt filtration system of Lewis by adding the embodiment taught by McInnis, in order to provide an alternative design for the filtration system wherein the backsplash is permanently attached/connected to the frame/frame members that support/hold the filtration medium, as an alternative design choice by the user and to lessen the number of parts for assembly. When the backsplash is formed unitarily/integrally (i.e. permanently attached) to the frame/frame members, there would be less parts to assemble and therefore would take less time for assembly of such a system.

14. Concerning claim 2, Lewis further discloses the filtration medium comprising a silt bag (38), as in figs. 1 – 2 and in col. 4.



15. With respect to claim 3, Lewis also discloses the system comprising cooperating front and rear support rods (28) extending between opposing side frame members (24) for suspending the bag (38) from said frame (22), as in figs. 2 & 8.

16. With regards to claim 4, Lewis further discloses the silt bag (38) comprising open-ended front and rear sleeves (44) formed along a top marginal portion thereof for receiving respective front and rear support rods (28), as in figs. 2 & 8.

17. Regarding claim 5, Lewis also discloses the frame (22) comprising cooperating pairs of generally V-shaped carriers (30) adapted for holding opposing ends (29) of respective front and rear support rods (28), as in figs. 2 - 5 & 8.

18. Concerning claim 6, Lewis discloses the frame further comprising first and second side support rods (32) extending between the front and rear frame members (26) and cooperating with the front and rear support rods (28) to suspend the silt bag (38) from the frame (22), as in figs. 2 - 3 & 8 and in cols. 4 - 6.

19. With respect to claim 7, Lewis further discloses the frame members (26, 24) comprising angle (i.e. L-shaped) irons/iron bars, as in figs. 2 - 5 and in cols. 4 - 5.

20. Concerning claim 9, Lewis as modified by McInnis, teach the backsplash comprising a lower splash panel (first portion deflecting upwardly from portion receiving the filter 26) attached to the frame member (i.e. the portion receiving the filter 26) and extending outwardly from the frame member at an angle greater than 90 degrees and less than 160 degrees relative to a notional plane extending through the frame member, as in fig. 2.

21. Claims 8 and 12 - 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lewis and McInnis, as applied to claim 1 above, and further in view of Autry et al. (US 5,480,254).

22. Regarding claim 8, Lewis as modified by McInnis, fail to disclose the system comprising at least one lift eye attached to the frame and adapted for receiving a lift hook used to remove said frame and filtration medium from the inlet of the catch basin. Autry et al. teach a silt filtration system (10) which is received within an inlet of a catch basin (24), the system comprising a frame (13, 11, 12) supporting therein a silt filter/rectangular bag filtration medium (21, 22) capable of separating silt and debris from storm water entering the catch basin, and the system (10) further comprising at least one lift eye (handle, 16) attached to the frame (members 13) and capable of receiving a lift hook used to remove said frame (13, 11, 12) and filtration medium (22, 21) from the inlet of the catch basin (24), as in figs. 1 - 3 and cols. 1 - 4. It is considered obvious to one of ordinary skill in the art at the time of the invention to modify the filtration system of Lewis as modified by McInnis, by adding the embodiment taught by Autry et

al., in order to provide a means for removing and accessing the filtration medium from the catch basin for cleaning and/or replacement thereof once it has been damaged or no longer effective as a filtration medium (reached the end of its useful life).

23. Concerning claim 12, Lewis as modified by McInnis and Autry et al. above, has taught at least one lift eye attached to the (one or more side frame members of the) frame and although the prior art do not teach two (a first and a second) lift eyes attached to respective side frame members, it is considered obvious to one of ordinary skill in the art at the time of the invention to modify the filtration system of Lewis, as modified by McInnis and Autry et al., by adding another lift eye, in addition to the first/at least one lift eye (16) taught by Autry et al., in order to provide an additional lifting means for removing the filtration medium from the catch basin. The case law, *In re Harza* [274 F.2d, 124 USPQ 378 (CCPA 1960)] in which a mere duplication of parts (in this instance, duplication of the lift eye from one to two) for a multiplied effect does not carry any patentable weight or significance unless a new or unexpected result is produced. See also M.P.E.P. section 2144.04 part VI paragraph B.

24. With respect to claim 13, Lewis as modified by McInnis, have taught the backsplash comprising a lower splash panel (first portion deflecting upwardly from portion receiving the filter 26) attached to the frame member (i.e. the portion receiving the filter 26) and extending outwardly from the frame member at an angle greater than 90 degrees and less than 160 degrees relative to a notional plane extending through the frame member, as in fig. 2 of McInnis.

*Allowable Subject Matter*

25. Claims 10 -11 and 14 - 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

26. The following is a statement of reasons for the indication of allowable subject matter: the closest prior art include Lewis (095), McInnis (484), Autry et al. (254) and Morris et al. (059). However, none of these prior art and those searched, have disclosed or rendered obvious a silt filtration system having the limitation of the backsplash further comprising an upper splash panel formed at angle greater than 90 degrees *and less than 160 degrees to the lower splash panel*, as in claims 10 and 14, and the system further comprising *opposing side splash panels attached to the backsplash and respective side frame members* to further deflect storm water into the filtration medium within the frame, as in claims 11 and 15.

*Conclusion*

27. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patents 4,419,232 (Arntyr et al.), 5,575,925 & 5,575,925 C1 (Logue Jr.), 6,274,036 B1 (Ellis), 6,517,709 B1 (Cardwell et al.), 6,368,499 B1 (Sharpless), 6,106,706 (Roy),

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6,086,758 (Schilling et al.), 3,713,539 (Thompson et al.), 2,615,526 (Lane) and 6,106,707 (Morris et al.) and WO 97/16609 (Roy et al.).

28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne S. Ocampo whose telephone number is (703) 305-1039. The examiner can normally be reached on Mondays to Fridays from 8:00 A.M. to 4:30 P.M..

29. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker can be reached on (703) 308-0457. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

30. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

*ms*  
M.S.O.  
April 17, 2003

*Joseph D. Dodge*  
JOSEPH DODGE  
PRIMARY EXAMINER